

# Hamilton County LAW LIBRARY NEWS

Professional legal information, services, and education

June 2017

## Does Copyright Now Cover Functionality?

By Chad Rutkowski and Robert Welsh of Baker, Hostetler, LLP. Reprinted with permission

On March 22, 2017, the U.S. Supreme Court decided the case of *Star Athletica, L.L.C. v. Varsity Brands, Inc.* regarding the scope of copyright protection for “pictorial, graphic or sculptural features” that have been added to useful articles—in this case, cheerleading uniforms. The case has mostly gained attention because its facts crystalize the tension between allowing copyright to subsist in designs applied to useful articles, while at the same time preventing copyright law from controlling the useful article’s functional aspects—which are not copyrightable. Most observers thought the central issue would be how to define a useful article’s function: Is a cheerleading uniform’s function to clothe the body and absorb perspiration (in which case the design at issue has no real coverage on functionality), or to identify the wearer as a cheerleader (in which case the design has quite a lot to do with the uniform’s functional-

ity)? Many, including these authors, expected the Court to sift through the ten different functionality tests that had been developed by the circuit courts and to either adopt one of the ten or develop some synthesis combining elements from different tests. What we received instead was a Gordian knot-slicing opinion by Justice Thomas that either will have little impact on what is currently considered copyrightable—or potentially will allow all manner of copyright “creep” over a useful article’s functionality.

We assume you are familiar with the facts and the issues. If not, here are our posts on the underlying district court [opinion](#), on the Supreme Court’s decision to accept [certification](#), and on an 11th Circuit [opinion](#) issued at around the same time as the 6th Circuit opinion. In those posts, we discussed our expectation that the Court might 1) clarify how to assess a useful

(Continued on page 4)

### Inside this issue:

Copyright	1
Tech Tip: Hein Online Session Laws	2
Upcoming CLE	5
You and the Legal System: Estate Planning	6
New Library Hours	6
Intellectual Property Resources	7

### Hamilton County Law Library

Hamilton County  
Courthouse  
1000 Main Street  
Room 601  
Cincinnati, OH 45202  
T:513.946.5300  
F:513.946.5264

Open Monday-Friday 8 - 4

<http://lawlibrary.hamilton-co.org>

## Tech Tip: HeinOnline—Session Law access for all 50 states and more

### By Systems Librarian, Julie Koehne

The law library has a wonderful database with many treasures called HeinOnline. One of the treasures to be aware of is our access to Session Laws. If you are of a firm of 50 or fewer subscribers, you have access to Hein Online remotely from our website and in our computer lab. If you are of a firm of more than 50 subscribers you may call us for materials or access the database here in the law library lab.

Regardless of how you open the database,  
once you are in, you will see the following home page.

The screenshot shows the HeinOnline homepage. At the top is a navigation bar with 'All Databases', 'MyHein', 'What's New', and 'Help'. Below this is a search bar with 'Search All Databases...' and a magnifying glass icon. To the left of the search bar is the HeinOnline logo. Below the search bar are tabs for 'Full Text', 'Citation', 'Catalog', and 'Case Law'. Under the 'Full Text' tab, there are links for 'Advanced Search', 'Search Help', and 'Search History'. The main content area is divided into two sections: 'Browse Databases by Category' and 'Browse Databases by Name'. In the 'Browse Databases by Category' section, there are links for 'Canada', 'Case Law', 'International Law (See Also: Canada, UK)', 'International Treaties and Agreements', 'Organizations', 'Periodicals', 'Special Collections', 'U.S. Federal', 'U.S. State', and 'United Kingdom'. In the 'Browse Databases by Name' section, there are two columns of links. The left column includes 'Law Journal Library', 'American Bar Association Journals', 'Core U.S. Journals', 'Criminal Justice Journals', 'International & Non-U.S. Law Journals', 'Most-Cited Law Journals', 'ABA Law Library Collection Periodicals', 'Acts of the Parliament of Canada (Annual Statutes)', 'American Association of Law Libraries (AALL)', and 'American Law Institute Library'. The right column includes 'Federal Reports', 'Legal Classics', 'Manual of Patent Examination Procedure', 'Martindale-Hubert Law Directory', 'Pentagon Papers', 'Revised Statutes of Canada', 'Session Laws Library', 'State Statutes: A Historical Archive', 'Statutes of the Realm', and 'Trends in Law Library Management and Technology'. A yellow callout bubble points to the 'Session Laws Library' link in the right column, stating: 'To access session laws, click on the "Session Law Library" link.' Below the 'Session Laws Library' link, there is a dropdown menu with the following options: 'Session Laws Library', 'All Titles', 'State Session Laws', 'State Statutes', 'Federal Laws', and 'Other Related Works'. A red box highlights the 'State Session Laws' option. A yellow callout bubble points to this option, stating: 'To view the session laws only, click on "State Sessions Laws."'

This database contains the session laws of all 50 U.S. states as well as Canada, Australia, Puerto Rico, Virgin Islands, and the D.C. Register. All states are current within 60 days of the printed publication, and all states are available back to inception!

Session Laws Library

HEINONLINE

Full Text Citation Catalog Case Law

Advanced Search | Search Help | Search History

Databases > Session Laws Library > U.S. State/Territory Laws

All Titles State Session Laws State Statutes Federal Laws Other Related

Session Laws Quick Locator

By Chapter Yr. Chapter/Act  
State [v] [ ] [ ] Search

By Page Yr. Page  
State [v] [ ] [ ] Search

Alabama	1818-2014; Including the Territory of Alabama (1818-1819)
Alaska	1913-2016; Including the Territory of Alaska (1913-1959)
Arizona	1864-2015; Including the Territory of Arizona (1864-1912)
North Dakota	1889-2015
<b>Ohio</b>	1788-2006; Including the Territory of Ohio (1788-1803)
Oklahoma	1890-2016; Including the Territory of Oklahoma (1890-1907)
Updated Oregon	1841-2016; Including the Territory of Oregon (1841-1859)
Oregon Law Index: An Index to Oregon Territorial and State Laws up to 1866	; Stevens-Ness Law Publishing Company. 1v. Portland, Ore: Stevens-Ness Law Pub. Co, 1937

You can search an individual state by clicking on the state name.

Session Laws Library

HEINONLINE

Full Text Citation Catalog Case Law

Search Session Laws Library...

Advanced Search | Search Help | Search History

Databases > Session Laws Library > Ohio

Ohio

1788-2006; Including the Territory of Ohio (1788-1803)

Ohio General Assembly

1701.11

Create eTOC Alert RSS

The results will show all the legislative changes that mention your search. Click on any blue text to view more detail.

Search for a particular phrase or a specific code section.

30 results searching for ((1701.11)) AND (volshortname:ssoh) in Session Laws

Sort by: Relevance

Check All Uncheck All MyHein Bookmarks Save/Email

2001-2002 vol. 149 I pt1 (Ohio - 124th General Assembly, Regular Session)  
Sub. S.B. No. 110

Turn to page  
Sub. S. B. No. 110 sections 1701.11, 1701.16, 1701.58, de are hereby repealed.  
Preident

All Matching Text Pages (2)

2001-2002 vol. 149 IV pt.1 (Ohio - 124th General Assembly, Regular Session)  
Sub. H.B. No. 278

Turn to page  
Sub. H. B. No. 278 Stc'roN2. That existing sections 111.16, 1329.58, 1701.04, 1701.07, 1701.11

All Matching Text Pages (5)

*(Continued from page one)*

article's "functions"; 2) clarify what public policy decisions should be considered in assessing the protectability of useful article designs; 3) engage in the kind of clear line-drawing that it did in *Dastar* and that it refrained from doing in *Mazer*; and 4) clarify what constitutes "separability." Somewhat surprisingly, the Court's opinion addressed only the fourth concern, and even then (consistent with Justice Thomas's "Scalian view" of statutory interpretation) the analysis was limited to generalized statements drawn from the actual words of the statute.

The Court stated that courts "need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities." The Court did not address concerns over functionality, impact on the market, or any other public policy concerns. Rather, under the Court's construction, separability is the beginning and end of the analysis—"In sum, a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium." The Court did not seem to care at all whether protection of the copyrightable feature would in turn impact, and thus extend protection to, the functionality of the article itself—"[t]he focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decision-maker to imagine a fully functioning useful article without the artistic feature." At the same time, the Court cautioned that the extension

of copyright protection to artistic elements incorporated in useful products does not incorporate purely functional elements: "To be clear, the only feature of the cheerleading uniform eligible for a copyright in this case is the two-dimensional work or art" and therefore, "Respondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut and dimensions to the one on which the decorations in this case appear."

In short, the formulation adopted by the Court creates uncertainty because it suggests that copyright protection over non-functional elements of a useful article may extend even beyond the scope of protection offered by design patents. Design patent law, although permitting some functionality to be implicated by the design, protect against converting an ornamental feature into a utilitarian one that monopolizes a function. See, e.g., *Seiko Epson Corp. v. Nu-Kote Int'l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999) (Design patent statute requires "that the design must not be governed solely by function, i.e., that this is not the only possible form of the article that could perform its function."). Under the Supreme Court's new standard, there appears to be no limitation on the extent to which a useful article's "functional capabilities" could become subject to copyright protection, so long as the copyrighted "pictorial, graphic or sculptural features" are found by the court to be non-functional.

This doctrine could have an enormous impact on industrial design. Take, for example, the fin of a 1959 Cadillac. Can the fins be imagined as standalone sculptures apart from the car? And even if they can, is the

separability requirement satisfied if the sculpture is merely understood to be a detached fin of a 1959 Cadillac as opposed to an independent artistic expression? Or consider the recent [example](#) of a sculptural element added to a USB drive but designed in a way to promote ease of use in plugging into a computer. Or of a software screen display that promotes intuitive use. Even within the fashion industry, the impact of the Varsity Brand decision remains uncertain. This was underscored by the Court's two dissenters—Justices Breyer and Kennedy—who purportedly applied the Court's test to reach the opposite result.

Under the Varsity Brand decision, considerations about the impact of subjective design decisions on functionality, or the impact on the market, or the impact on the underlying article itself, are now all irrelevant. If the copyrighted matter can stand alone conceptually as a work of art, its application to a useful article is subject to copyright protection.

For more information, contact [Chad Rutkowski](#) or [Robert Welsh](#).

## Westlaw Training Available

Westlaw trainer Samuel Berbano will be here in our computer lab on Thursday, June 15th from 9am-11am to answer questions, and help with complex research requests. Feel free to stop in. If you have any questions,

contact us at 513.946.5300 or [reference@cms.hamilton-co.org](mailto:reference@cms.hamilton-co.org)

**\*Note-this is not a CLE event.**

## Upcoming CLE

Free to subscribers; \$50 for non-subscribers  
Registration is required.

To register, call 513.946.5300, email [reference@cms.hamilton-co.org](mailto:reference@cms.hamilton-co.org), or register via the website <http://lawlibrary.hamiltoncountyohio.gov/classes/calendar/>

### How the Statute of Limitations for Trusts Funded by Pour Over Wills has Changed and What Can be Done

Presenter: John Cobey

Friday, June 9

Noon-1pm

A peril of Probate Practice: Do pour over wills incorporate the trust by reference? Is that trust's assets subject to inclusion in the probated estate? If you answer "no" to both, come to the seminar and hear speaker John Cobey review the ramifications of *Gerhke v. Senkiw* and discuss what to do about your old and future wills and trusts. Approved for 1.0 hour of general credit in Ohio and Kentucky.

### Legal Issues in Boxing

Presenter: Carl Lewis

Wednesday, July 12

Noon-1pm

The program will include a general review of Ohio's Athletic Commission rules and regulations governing promoters, managers and fighters, as well as contractual issues and recent litigation involving boxing and mixed martial arts. Approved for 1.0 hour of general CLE credit in Ohio and Kentucky.



## Staffing Change

Vanessa Reams, our library assistant, is leaving the Hamilton County Law Library on May 18. Vanessa has been with us in this position since March 2013. She has been an important part of our library team during her time here, and I know that our staff and patrons will miss her. We wish her all the best in her new endeavors!



## New Hours

Due to staffing shortages, beginning July 24, 2017 and continuing for several months, the Law Library will be closing to both the public and subscribers at 4pm. Any patrons in the library will need to finish their work before that time. Any reference requests by subscribers off-site should be submitted by 3:30pm for consideration the same day.

Solo subscribers, full-firm subscribers and county government employees are encouraged to use our online databases, which are available 24/7 for your ease of use. If you need information about how to access these databases, please feel free to contact our reference librarians at

[reference@cms.hamilton-co.org](mailto:reference@cms.hamilton-co.org).

or by calling 513-946-5300.

## You and the Legal System: Estate Planning-The Important Documents that Every Family Must Have

Attorney Scott Hoberg will discuss Estate Planning on Friday, June 16 at noon in the Law Library.

To register, call 513.946.5300 or register via our website at

<https://lawlibrary.hamiltoncountyohio.gov/event-registration/?ee=113>

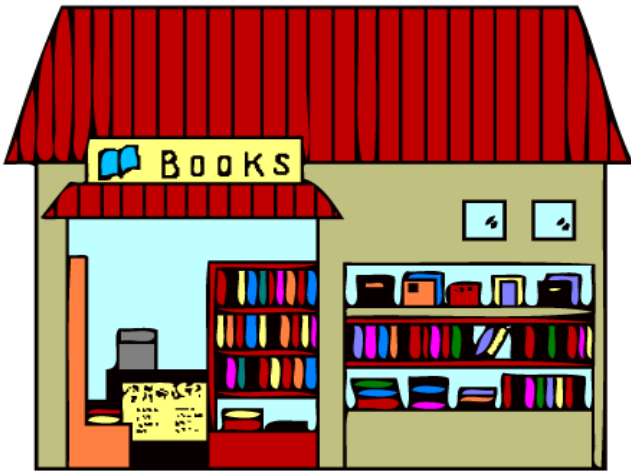
Please note that this is not a CLE event; it is intended for the general public. However, attorneys are welcome to attend and may want to pass along the program announcement to clients, staff and community organizations. If you would like more information, please contact [Vanessa Seeger](#).

*You and the Legal System* is brought to you as a public service by the Hamilton County Law Library, in conjunction with the Cincinnati Bar Association's Lawyer Referral Service. Save the date for the next event in our *You and the Legal System* series. Ronna Lucas will discuss Lemon Law on Friday, July 21.



## Library Books for Sale!

When the Law Library withdraws materials from our collection, we sell them on the county auction site. If you follow this [link](#), you can review what we have to offer and make your bids to get the first shot at getting the best materials to supplement your personal library. If the books don't sell at auction, however, we are now going to be selling many of them in the library at low prices. If you're interested in perusing what we have to offer, please take a look at the shelves in our copy room and feel free to ask a reference librarian for assistance or more details. Items will be sold on first-come, first-served basis, so stop in often to see what goodies you might find!



## Intellectual Property Resources-Remote Access

Law Library subscribers have remote access\* to a variety of online resources on Intellectual Property. If you have questions, or have a suggestion for a title to add, contact the reference staff at [reference@cms.hamilton-co.org](mailto:reference@cms.hamilton-co.org) or 513.946.5300

### CCH Intelliconnect

Title 21 C.F.R. - Food & Drugs  
 Title 37 C.F.R. - Patents, Trademarks & Copyrights  
 Copyright Law Reporter  
 Guide to Computer Law  
 Patent Reform Law - Leahy-Smith America Invents Act  
 Trademark Law Guide

### Fastcase Loislaw Treatises

Epstein on Intellectual Property, 5th edition  
 Guide to Registering Trademarks  
 Guide to Trademark Trial and Appeal Board Practice  
 Handbook of Intellectual Property Claims and Remedies  
 Trademark Law: Protection, Enforcement and Licensing, 2nd edition  
 Trademark and Copyright Disputes: Litigation Forms and Analysis

### EBSCO

Copyright Handbook  
 Patent, Copyright & Trademark  
 Public Domain: How to Find & Use  
 Patent It Yourself  
 Patent Pending in 24 Hours  
 Patent Savvy for Managers  
 Patent Searching Made Easy  
 Trademark: Legal Care for Your Business & Product Name

\*Remote access is available to subscribers who are solos or firm attorneys whose entire firm has a subscription to the Law Library.

## Upcoming Events:

June 9: CLE: How the Statute of Limitations for Trusts Funded by Pour Over Wills has Changed and What Can be Done

June 16: You and the Legal System: Estate Planning

July 12: CLE: Legal Issues in Boxing

July 21: You and the Legal System: Ohio Lemon Law



# June 2017 Law Library Newsletter

- INSIDE THIS MONTH**
- Copyright
  - Tech Tip: Hein Online
  - CLE
  - You and the Legal System: Estate Planning
  - Library Book sale

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Cincinnati, OH 45202